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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$330.00

Complete if Known	
Application Number	09/736,548
Filing Date	13 December 2000
First Named Inventor	Schumann
Examiner Name	Victor S. Chang
Art Unit	1771
Attorney Docket No.	tesa AG 685/ 101769-90

**METHOD OF PAYMENT** (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number: 14-1263

Deposit Account Name: Norris, McLaughlin & Marcus

The Director is authorized to: (check all that apply)

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**FEE CALCULATION**

**1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	2001	770	385	Utility filing fee	
1002	2002	340	170	Design filing fee	
1003	2003	530	265	Plant filing fee	
1004	2004	770	385	Reissue filing fee	
1005	2005	160	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

**2. EXTRA CLAIM FEES FOR UTILITY AND**

Extra Claims	Fee from below	Fee Paid
Total Claims -20** = 0	X	0.00
Independent Claims -3** = 0	X	0.00
Multiple Dependent		

**Large Entity** **Small Entity**

Fee Code	Fee (\$)	Fee Description
1202	18	2202 9 Claims in excess of 20
1201	86	2201 43 Independent claims in excess of 3
1203	290	2203 145 Multiple dependent claim, if not paid
1204	86	2204 43 ** Reissue independent claims over original patent
1205	18	2205 9 ** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2) (\$)		

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)**

**3. ADDITIONAL FEES**

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	2051	130	65	Surcharge - late filing fee or oath	
1052	2052	50	25	Surcharge - late provisional filing fee or cover sheet	
1053	1053	130	130	Non - English specification	
1812	1812	2,520	2,520	For filing a request for ex parte reexamination	
1804	1804	920*	920*	Requesting publication of SIR prior to Examiner action	
1805	1805	1,840*	1,840*	Requesting publication of SIR after Examiner action	
1251	2251	110	55	Extension for reply within first month	
1252	2252	420	210	Extension for reply within second month	
1253	2253	950	475	Extension for reply within third month	
1254	2254	1,480	740	Extension for reply within fourth month	
1255	2255	2,010	1,005	Extension for reply within fifth month	
1401	2401	330	165	Notice of Appeal	
1402	2402	330	165	Filing a brief in support of an appeal	330.00
1403	2403	290	145	Request for oral hearing	
1451	1451	1,510	1,510	Petition to institute a public use proceeding	
1452	2452	110	55	Petition to revive - unavoidable	
1453	2453	1,330	665	Petition to revive - unintentional	
1501	2501	1,330	665	Utility issue fee (or reissue)	
1502	2502	480	240	Design issue fee	
1503	2503	640	320	Plant issue fee	
1460	1460	130	130	Petitions to the Commissioner	
1807	1807	50	50	Processing fee under 37 CFR § 1.17(q)	
1806	1806	180	180	Submission of Information Disclosure Statement	
8021	8021	40	40	Recording each patent assignment per property (times number of properties)	
1809	2809	770	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	2810	770	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	2801	770	385	Request for Continued Examination (RCE)	
1802	1802	900	900	Request for expedited examination of a design application	
Other fee (specify)					
SUBTOTAL (3) (\$)					330.00

**SUBMITTED BY**

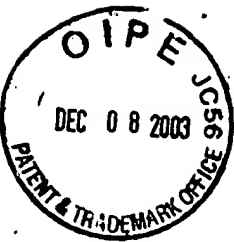
Name (Print/Type)	Registration No. (Attorney/Agent)	Telephone
Howard C. Lee	48,104	212-808-0700

Signature: Howard C. Lee Date: 8 December 2003

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tesa AG 685-HCL  
101769-90  
3162-St-sti

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANTS : SCHÜMANN et al.  
SERIAL NO. : 09/736,548  
FILED : 13 December 2000  
FOR : ADHESIVE TAPE, IN PARTICULAR FOR MAKING A CATHODIC  
ELECTROCOAT PRIMER  
ART UNIT : 1771  
EXAMINER : Victor S. Chang

**8 December 2003**

**Mail Stop: Appeal Brief - Patents**  
Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 1.192**

SIR:

This is an appeal from the final rejection dated 26 December 2002.

**(1) REAL PARTY IN INTEREST**

The real party in interest is **tesa AG** which is a subsidiary of Beiersdorf AG. Beiersdorf AG received a Notice of Recordation of Assignment on at Reel 011396, Frame 0717 (Recorded on 13 December 2000).

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals and interferences.

12/11/2003 DTESSEM1 00000050 141263 09736548

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### (3) STATUS OF CLAIMS - SUMMARY OF PROSECUTION HISTORY

Claims 1 and 4-11 stand rejected.

Action number from PAIR	Content Description	Comments
38 (12/8/2003)	Appeal Brief #2	This paper
37 (12/3/2003)	Mail Advisory Action	Have not yet received advisory action as of this date but presumed to indicate that claims are not allowed. Had previously requested examiner telephone the applicants' representative if allowable subject matter were found and no call had been received to date.
32 (10/8/2003)	Amendment After Final Rej. Notice of Appeal	(see comment on page 2 of Amendment After Final Rej. - "Waiver of Petition of Finality of Rejection")
30 (7/8/2003)	Mail Final Rejection	
27 (5/27/2003)	Appeal Brief #1	
25 (4/4/2003)	Mail Advisory Action	
23 (3/26/2003)	Amendment After Final Rej. Notice of Appeal	
18 (12/13/2002)	Final rejection	
16 (11/27/2002)	Response to Non-Final Action	
13 (5/29/2002)	Non-final Rejection	
1 (12/13/2000)	Initial Exam Team In (Filing Date)	3-year clock for PTA starts on 12/13/2003 Prosecution PTA stands at +15 days

### (4) STATUS OF AMENDMENTS

It appears that all amendments have been entered. The After-Final response dated 26 March 2003 included an amendment to the specification which was stated to be entered in the Advisory Action dated 4 April 2003 (Paper No. 13). No amendments were made to the claims in the After-Final response.

**(5) SUMMARY OF INVENTION**

The present invention as represented by claim 1 relates to an adhesive tape provided on one side with a self-adhesive composition and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin, wherein:

- the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;

and wherein

- said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; aliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.

Support for this invention can be found, for example, on page 21 (originally filed claims 1-3)

Support for the subject matter of claims 4-10 can be found, for example on page 21 (originally filed claims 4-10). Claim 11 reintroduces the deleted "particular preference" ranges of originally filed claim 4.

**(6) ISSUES**

The lone remaining issue is whether claims 1 and 4-11 are obvious or non-obvious in light of Kinzer et al. (U.S. Patent 5,667,893) alone or in view of Wiest et al. (U.S. Patent 4,322,516) as applied to claims 6 and 11. (Sobel (U.S. Patent 3,609,190) is presented as evidence by the examiner that some amines may be hardeners)

**(7) GROUPING OF CLAIMS**

For the purpose of this Appeal Brief, the claims will be divided into three groups:

- (1) Claims 1, 4-7 and 11 are directed toward an adhesive tape with claims 1, 4 and 5 standing of falling together; claim 7 will be argued separately. Claims 6 and 11 will also be argued separately.
- (2) Claim 8 is directed toward a method of masking window flanges.
- (3) Claims 9 and 10 are directed toward a process of making the adhesive tape of claim 1.

**(8) ARGUMENT**

***Summary of Arguments***

- (a) Kinzer does not teach an epoxy component AND an amine component as part of the crosslinked epoxy resin.
- (b) Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked.
- (c) No reasonable expectation of success for modification to Kinzer given the other elements of their invention.
- (d) Kinzer does not teach the limitation of claim 7.
- (e) Kinzer does not teach the method of using (claim 8) or the process of making (claims 9 and 10) the adhesive tape of claim 1.
- (f) Kinzer in view of Wiest does not teach the adhesive tape compositions with the self-adhesive compositions of claims 6 and 11.

***Restatement of the Facts***

The essential elements of the appellant's broadest claim (claim 1) is compared with the "Summary of the Invention" of Kinzer is represented in the table below (see next page):

Appellants' claim 1	Kinzer "Summary of the Invention" (paraphrased)
An <b>adhesive tape</b> provided on one side with a <b>self-adhesive composition</b>	An article (flexible tape backing or a chip resistant paint)
and comprising a backing material comprising a <b>polyester film coated with a crosslinked epoxy resin</b> , wherein	comprising a substrate coated with a <b>flexible epoxy composition</b>
the <b>crosslinked epoxy resin</b> is prepared using <b>epoxy resins selected from</b> the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;	wherein the <b>photopolymerizable</b> epoxy composition comprises: (a) a <b>plurality of epoxides</b> including at least one selected from the group consisting of cycloaliphatic epoxides and bisphenol A epoxide,
and wherein said epoxy resins are cured using a <b>curing agent selected from</b> the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; araliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.	
	and at least one different aliphatic epoxide,
	(b) from about 0.1 to about 2% of at least one organometallic cationic initiator capable of initiating polymerization at wavelengths of from 200 to about 600 nm, and
	(c) optionally, at least one accelerating agent,

Viewing Kinzer in a light most favorable to the examiner's position, it can be argued that the appellants limitations represented in appellants' claim 4 and 5 are possible additional elements for Kinzer's invention. However, the most glaring difference between the appellants' invention and that of Kinzer is the lack of an explicit recitation for the use of an amine.

#### **Arguments in favor of non-obviousness**

- (a) Kinzer does not teach an epoxy component AND an amine component as part of the crosslinked epoxy resin.

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d

981, 180 USPQ 580 (CCPA 1974)). However, the examiner's reliance on Kinzer alone to reject appellants' claims 1, 4, 5 and 7-10 does not adequately consider the Kinzer reference "as a whole" as is required by the four tenets of patent law for applying 35 U.S.C. 103 as outlined in MPEP 2141 (page 2100-143, Feb. 2003 rev.)

The examiner had previously stated in his Advisory Action (Paper No. 13) that Kinzer "...may also include hardeners (i.e. amines), etc. (column 6, lines 17-21)." However, the appellants believe this interpretation fails to consider the teachings of Kinzer "as a whole".

The characterization of hardeners as being equivalent to amines comes from the examiner *not* from the teachings of Kinzer. Furthermore, the recitation of hardeners is within a Markush-like grouping of optional adjuvants (col. 6, lines 17-21 from Kinzer is reproduced below):

**Compositions of the invention may also include optional adjuvants such as co-curatives, hardeners, fillers, plasticizers, pigments, antioxidants, surface modifying agents, and the like, in amounts such that they do not interfere with the photopolymerization of the epoxides.**

It has long been held that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)). This concept has been more recently been affirmed in *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998):

"Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention; rather, there must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed.Cir.2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed.Cir.1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 U.S.P.Q.2d 1321, 1324 (Fed.Cir.1990) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed composition); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed.Cir.1985)."

For the present situation, Kinzer does not teach or suggest that one of ordinary skill practice and of the following:

- (1) that the adjuvants are required elements which must be part of Kinzer's invention;
- (2) that hardeners are preferably selected from the Markush group of adjuvants; and
- (3) the hardener must be an amine.

(The Sobel reference is of little value in remedying any deficiencies with regard to Kinzer as it only serves to indicate that some amines can be hardeners; there is no recitation that all amines are equivalent to hardeners, merely those taught by Sobel are hardeners.

Any argument that it should be permissible to "pick and choose" elements from within the teaching of Kinzer would be counteracted by the sheer volume of possible embodiments should such a standard be allowed. The court of *In re Rice*, 178 USPQ 478 (CCPA 1973) held that, "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *Id.* at 480. The list of optional ingredients which could be added if taking the suggestion from col. 6, lines 17-21 of Kinzer seriously would result in a virtually infinite number of permutations of the invention of Kinzer. Not only is there no direction as to which adjuvant one to select, there is no teaching for selecting a particular species of that adjuvant (i.e. amines) and therefore combination of an amine with the teachings of Kinzer is unobvious.

- (b) Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked.**

Even if *in arguendo* there was some rationale to "pick and choose" an amine in the teachings of Kinzer, there is nothing within the Kinzer reference which teaches or suggests a crosslinked epoxy resin as in the appellants' invention.

If the examiner had been relying on inherency to establish that Kinzer et al. teaches a crosslinked epoxy resin via the use of an amine, no recitation of facts were acknowledged in support of such a position.

MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "*The fact that a certain result or characteristic may occur or be present in the prior art is not*



*sufficient to establish the inherency of that result or characteristic. In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)...To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In the present situation, not only is there no factual basis for establishing that Kinzer teaches or is inherently a crosslinked product, there are indications from within Kinzer's own specification that it is not:

- (1) the discussion in Kinzer's "Description of the Related Art" speaks to polymerized, crosslinked structures but also to the problems associated with them which suggests that Kinzer's invention is directed away from the prior art methods. Furthermore, when given the opportunity to describe his own invention, Kinzer distinctly refuses to characterize his invention as a crosslinked polymer;
  - (2) Kinzer appears to teach away from their intended epoxy composition being crosslinked as it is described in their Summary of the Invention that "...the present invention provides an article comprising a substrate coated with a **flexible** epoxy composition" or "**photopolymerizable**" epoxy composition.
- (c) **No reasonable expectation of success for modification to Kinzer given the other elements of their invention.**

The ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)).

However, given the additional components which are required by Kinzer et al.'s epoxy composition (i.e. "at least one organometallic cationic initiator") and other optional ingredients

thereof ("optionally, at least one accelerating agent" (i.e. peroxides) - see col. 5, line 64 - col. 6, line 3 of Kinzer) and that even in Kinzer's broad recitation of the use of "hardeners" there is included the caveat that such additions are made "in amounts not to interfere with the photopolymerization of the epoxides", there has been no factual basis established for a reasonable expectation of success to add amines to the invention of Kinzer as indicated by the examiner.

MPEP 2143.01 states "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Kinzer's claimed invention is directed toward "an article comprising a substrate which has coated thereon a **photopolymerizable** epoxy composition". There is no indication that Kinzer also contemplates crosslinked epoxy resins as in the appellants' claimed invention. Kinzer defines "photopolymerization" in col. 3, lines 31-35:

**1. The term "photopolymerizable" means that a compound or composition is capable of polymerizing (i.e., being fully cured) when irradiated preferably by ultra-violet emissions in the range of from about 180 nm to about 420 nm.**

As such, there is no motivation for one of ordinary skill in the art to select an amine component within the context of Kinzer's invention as this would produce a different epoxy composition than that contemplated by Kinzer.

**(d) Kinzer does not teach the limitation of claim 7.**

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." As Kinzer is primarily preoccupied with their photopolymerizable epoxy compositions, scant attention is paid to their self-adhesive compositions and nowhere is there a recitation that their self-adhesive composition has a thickness of from 15 to 40  $\mu\text{m}$ .

- (e) Kinzer does not teach the method of using (claim 8) or the process of making (claims 9 and 10) the adhesive tape of claim 1.**

The primary thrust of the examiner's rejection had been against independent claim 1. However, it has never been adequately explained how the Kinzer reference renders the method of use claim or the product of making claim to be obvious as the reference to the adhesive tape and its uses was only made in passing in the Kinzer reference; most of the energies in Kinzer was directed toward the epoxy composition.

- (f) Kinzer in view of Wiest does not teach the adhesive tape compositions with the self adhesive compositions of claims 6 and 11.**

Should the rejection of Kinzer be reversed this rejection would also be reversed. However, further arguments against the combination of Kinzer in view of Wiest are made below in the event that the rejection based on Kinzer is affirmed.

Wiest describes a copolymer which has ranges for the amount of ethylene, vinyl acetate, acrylic acid and methacrylamide which overlaps that of the appellants' claims (presuming that there is equivalence for methacrylamide (Wiest) and acrylamide (appellants)). However, what is lacking is any motivation or suggestion to combine the teachings which come from the references themselves or from the known state of the art. The examiner's explanation appears to be based on hindsight reconstruction (i.e. presumes that the skilled artisan would have had a copy of the appellants' claims before him when considering the scope of the inventions represented by Kinzer and Wiest). This is not permissible according to MPEP 2142.

Going back in time to the filing date of the applicants claimed invention without the benefit of the appellants claims, one of ordinary skill in the art would already have to have made the remarkable selection of an amine despite the infinite number of additional adjuvants which could be selected and lack of knowledge of the success of using an amine and would then proceed to again pick among the infinite number of copolymers available to select the one described by Wiest. Such a presumption strains credulity and therefore, such a combination would not render the appellants' claimed invention to be obvious.

**(9) CONCLUSION**

For any of the foregoing reasons, Appellants respectfully request that the Honorable Board reverse the final rejection of claims 1 and 4-11.

<b>CONDITIONAL PETITION FOR EXTENSION OF TIME</b>
---

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

<b>ADDITIONAL FEE</b>
-----------------------

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,  
NORRIS MCLAUGHLIN & MARCUS, P.A.

By *Howard C. Lee*  
Howard C. Lee  
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220 E. 42<sup>nd</sup> Street  
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New York, NY 10017  
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tesa AG 685-HCL  
101769-90  
3162-St-sti

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22313-1450 on  
8 December, 2003.

NORRIS, McLAUGHLIN & MARCUS, P.A.

By Agata Glinzka

Agata Glinzka

Date 8 December, 2003

**(10) APPENDIX - CLAIMS ON APPEAL**

1. An adhesive tape provided on one side with a self-adhesive composition and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin, wherein  
  
the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;  
  
and wherein said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; araliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.
4. The adhesive tape according to Claim 1, wherein the crosslinked epoxy resin comprises fillers, plasticizers and, optionally, auxiliaries and additives as further formulating constituents.
5. The adhesive tape according to Claim 1, wherein on the reverse of the crosslinked epoxy resin there is a release coating.
6. The adhesive tape according to Claim 1, wherein the self-adhesive composition has the following makeup:

ethylene	from 10 to 30% by weight
vinyl acetate	from 20 to 55% by weight
acrylic ester	from 30 to 69% by weight
acrylamide	from 0 to 8% by weight.
7. The adhesive tape according to Claim 1, wherein the self-adhesive composition has a thickness of from 15 to 40  $\mu\text{m}$ .
8. A method for masking window flanges which comprises applying the tape of Claim 1 to said flanges.

9. A process for producing the adhesive tape of claim 1, which comprises applying a mixture of starting components of the epoxy resin during their chemical reaction phase directly on the polyester film.
10. The process of claim 9, wherein the polyester film is provided with the self-adhesive composition prior to coating with the crosslinked epoxy resin opposite the side to be coated with epoxy resin.
11. The adhesive tape of Claim 6, wherein
  - the amount of ethylene is 10 to 15% by weight,
  - the amount of vinyl acetate is 30 to 35% by weight,
  - the amount of acrylic ester is 50 to 60% by weight,
  - the amount of acrylamide is 0.5% by weight.



tesa AG 685-HCL  
101769-90  
3162-St-sti

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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FOR : ADHESIVE TAPE, IN PARTICULAR FOR MAKING A CATHODIC  
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ART UNIT : 1771  
EXAMINER : Victor S. Chang

**8 December 2003**

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Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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SIR:

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**(1) REAL PARTY IN INTEREST**

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**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals and interferences.



### (3) STATUS OF CLAIMS - SUMMARY OF PROSECUTION HISTORY

Claims 1 and 4-11 stand rejected.

Action number from PAIR	Content Description	Comments
38 (12/8/2003)	Appeal Brief #2	This paper
37 (12/3/2003)	Mail Advisory Action	Have not yet received advisory action as of this date but presumed to indicate that claims are not allowed. Had previously requested examiner telephone the applicants' representative if allowable subject matter were found and no call had been received to date.
32 (10/8/2003)	Amendment After Final Rej. Notice of Appeal	(see comment on page 2 of Amendment After Final Rej. - "Waiver of Petition of Finality of Rejection")
30 (7/8/2003)	Mail Final Rejection	
27 (5/27/2003)	Appeal Brief #1	
25 (4/4/2003)	Mail Advisory Action	
23 (3/26/2003)	Amendment After Final Rej. Notice of Appeal	
18 (12/13/2002)	Final rejection	
16 (11/27/2002)	Response to Non-Final Action	
13 (5/29/2002)	Non-final Rejection	
1 (12/13/2000)	Initial Exam Team In (Filing Date)	3-year clock for PTA starts on 12/13/2003 Prosecution PTA stands at +15 days

### (4) STATUS OF AMENDMENTS

It appears that all amendments have been entered. The After-Final response dated 26 March 2003 included an amendment to the specification which was stated to be entered in the Advisory Action dated 4 April 2003 (Paper No. 13). No amendments were made to the claims in the After-Final response.

**(5) SUMMARY OF INVENTION**

The present invention as represented by claim 1 relates to an adhesive tape provided on one side with a self-adhesive composition and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin, wherein:

- the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;

and wherein

- said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; aliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.

Support for this invention can be found, for example, on page 21 (originally filed claims 1-3)

Support for the subject matter of claims 4-10 can be found, for example on page 21 (originally filed claims 4-10). Claim 11 reintroduces the deleted "particular preference" ranges of originally filed claim 4.

**(6) ISSUES**

The lone remaining issue is whether claims 1 and 4-11 are obvious or non-obvious in light of Kinzer et al. (U.S. Patent 5,667,893) alone or in view of Wiest et al. (U.S. Patent 4,322,516) as applied to claims 6 and 11. (Sobel (U.S. Patent 3,609,190) is presented as evidence by the examiner that some amines may be hardeners)

**(7) GROUPING OF CLAIMS**

For the purpose of this Appeal Brief, the claims will be divided into three groups:

- (1) Claims 1, 4-7 and 11 are directed toward an adhesive tape with claims 1, 4 and 5 standing of falling together; claim 7 will be argued separately. Claims 6 and 11 will also be argued separately.
- (2) Claim 8 is directed toward a method of masking window flanges.
- (3) Claims 9 and 10 are directed toward a process of making the adhesive tape of claim 1.

**(8) ARGUMENT**

***Summary of Arguments***

- (a) Kinzer does not teach an epoxy component AND an amine component as part of the crosslinked epoxy resin.
- (b) Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked.
- (c) No reasonable expectation of success for modification to Kinzer given the other elements of their invention.
- (d) Kinzer does not teach the limitation of claim 7.
- (e) Kinzer does not teach the method of using (claim 8) or the process of making (claims 9 and 10) the adhesive tape of claim 1.
- (f) Kinzer in view of Wiest does not teach the adhesive tape compositions with the self-adhesive compositions of claims 6 and 11.

***Restatement of the Facts***

The essential elements of the appellant's broadest claim (claim 1) is compared with the "Summary of the Invention" of Kinzer is represented in the table below (see next page):

Appellants' claim 1	Kinzer "Summary of the Invention" (paraphrased)
An <b>adhesive tape</b> provided on one side with a <b>self-adhesive composition</b>	An article (flexible tape backing or a chip resistant paint)
and comprising a backing material comprising a <b>polyester film coated with a crosslinked epoxy resin</b> , wherein	comprising a substrate coated with a <b>flexible epoxy composition</b>
the <b>crosslinked epoxy resin</b> is prepared using <b>epoxy resins selected from</b> the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;	wherein the <b>photopolymerizable</b> epoxy composition comprises: (a) a <b>plurality of epoxides</b> including at least one selected from the group consisting of cycloaliphatic epoxides and bisphenol A epoxide,
and wherein said epoxy resins are cured using a <b>curing agent selected from</b> the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; aliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.	
	and at least one different aliphatic epoxide,
	(b) from about 0.1 to about 2% of at least one organometallic cationic initiator capable of initiating polymerization at wavelengths of from 200 to about 600 nm, and
	(c) optionally, at least one accelerating agent,

Viewing Kinzer in a light most favorable to the examiner's position, it can be argued that the appellants limitations represented in appellants' claim 4 and 5 are possible additional elements for Kinzer's invention. However, the most glaring difference between the appellants' invention and that of Kinzer is the lack of an explicit recitation for the use of an amine.

#### **Arguments in favor of non-obviousness**

- (a) Kinzer does not teach an epoxy component AND an amine component as part of the crosslinked epoxy resin.

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d

981, 180 USPQ 580 (CCPA 1974)). However, the examiner's reliance on Kinzer alone to reject appellants' claims 1, 4, 5 and 7-10 does not adequately consider the Kinzer reference "as a whole" as is required by the four tenets of patent law for applying 35 U.S.C. 103 as outlined in MPEP 2141 (page 2100-143, Feb. 2003 rev.)

The examiner had previously stated in his Advisory Action (Paper No. 13) that Kinzer "...may also include hardeners (i.e. amines), etc. (column 6, lines 17-21)." However, the appellants believe this interpretation fails to consider the teachings of Kinzer "as a whole".

The characterization of hardeners as being equivalent to amines comes from the examiner *not* from the teachings of Kinzer. Furthermore, the recitation of hardeners is within a Markush-like grouping of **optional adjuvants** (col. 6, lines 17-21 from Kinzer is reproduced below):

**Compositions of the invention may also include optional adjuvants such as co-curatives, hardeners, fillers, plasticizers, pigments, antioxidants, surface modifying agents, and the like, in amounts such that they do not interfere with the photopolymerization of the epoxides.**

It has long been held that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)). This concept has been more recently been affirmed in *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998):

"Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention; rather, there must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed.Cir.2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed.Cir.1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 U.S.P.Q.2d 1321, 1324 (Fed.Cir.1990) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed composition); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed.Cir.1985)."

For the present situation, Kinzer does not teach or suggest that one of ordinary skill practice and of the following:

- (1) that the adjuvants are required elements which must be part of Kinzer's invention;
- (2) that hardeners are preferably selected from the Markush group of adjuvants; and
- (3) the hardener must be an amine.

(The Sobel reference is of little value in remedying any deficiencies with regard to Kinzer as it only serves to indicate that some amines can be hardeners; there is no recitation that all amines are equivalent to hardeners, merely those taught by Sobel are hardeners.

Any argument that it should be permissible to "pick and choose" elements from within the teaching of Kinzer would be counteracted by the sheer volume of possible embodiments should such a standard be allowed. The court of *In re Rice*, 178 USPQ 478 (CCPA 1973) held that, "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *Id.* at 480. The list of optional ingredients which could be added if taking the suggestion from col. 6, lines 17-21 of Kinzer seriously would result in a virtually infinite number of permutations of the invention of Kinzer. Not only is there no direction as to which adjuvant one to select, there is no teaching for selecting a particular species of that adjuvant (i.e. amines) and therefore combination of an amine with the teachings of Kinzer is unobvious.

- (b) Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked.**

Even if *in arguendo* there was some rationale to "pick and choose" an amine in the teachings of Kinzer, there is nothing within the Kinzer reference which teaches or suggests a crosslinked epoxy resin as in the appellants' invention.

If the examiner had been relying on inherency to establish that Kinzer et al. teaches a crosslinked epoxy resin via the use of an amine, no recitation of facts were acknowledged in support of such a position.

MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "The fact that a certain result or characteristic may occur or be present in the prior art is not

*sufficient to establish the inherency of that result or characteristic. In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)...To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In the present situation, not only is there no factual basis for establishing that Kinzer teaches or is inherently a crosslinked product, there are indications from within Kinzer's own specification that it is not:

- (1) the discussion in Kinzer's "Description of the Related Art" speaks to polymerized, crosslinked structures but also to the problems associated with them which suggests that Kinzer's invention is directed away from the prior art methods. Furthermore, when given the opportunity to describe his own invention, Kinzer distinctly refuses to characterize his invention as a crosslinked polymer;
  - (2) Kinzer appears to teach away from their intended epoxy composition being crosslinked as it is described in their Summary of the Invention that "...the present invention provides an article comprising a substrate coated with a *flexible* epoxy composition" or "*photopolymerizable*" epoxy composition.
- (c) **No reasonable expectation of success for modification to Kinzer given the other elements of their invention.**

The ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

However, given the additional components which are required by Kinzer et al.'s epoxy composition (i.e. "at least one organometallic cationic initiator") and other optional ingredients

thereof ("optionally, at least one accelerating agent" (i.e. peroxides) - see col. 5, line 64 - col. 6, line 3 of Kinzer) and that even in Kinzer's broad recitation of the use of "hardeners" there is included the caveat that such additions are made "in amounts not to interfere with the photopolymerization of the epoxides", there has been no factual basis established for a reasonable expectation of success to add amines to the invention of Kinzer as indicated by the examiner.

MPEP 2143.01 states "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Kinzer's claimed invention is directed toward "an article comprising a substrate which has coated thereon a **photopolymerizable** epoxy composition". There is no indication that Kinzer also contemplates crosslinked epoxy resins as in the appellants' claimed invention. Kinzer defines "photopolymerization" in col. 3, lines 31-35:

1. The term "photopolymerizable" means that a compound or composition is capable of polymerizing (i.e., being fully cured) when irradiated preferably by ultra-violet emissions in the range of from about 180 nm to about 420 nm.

As such, there is no motivation for one of ordinary skill in the art to select an amine component within the context of Kinzer's invention as this would produce a different epoxy composition than that contemplated by Kinzer.

**(d) Kinzer does not teach the limitation of claim 7.**

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." As Kinzer is primarily preoccupied with their photopolymerizable epoxy compositions, scant attention is paid to their self-adhesive compositions and nowhere is there a recitation that their self-adhesive composition has a thickness of from 15 to 40  $\mu\text{m}$ .



- (e) Kinzer does not teach the method of using (claim 8) for the process of making (claims 9 and 10) the adhesive tape of claim 1.**

The primary thrust of the examiner's rejection had been against independent claim 1. However, it has never been adequately explained how the Kinzer reference renders the method of use claim or the product of making claim to be obvious as the reference to the adhesive tape and its uses was only made in passing in the Kinzer reference; most of the energies in Kinzer was directed toward the epoxy composition.

- (f) Kinzer in view of Wiest does not teach the adhesive tape compositions with the self adhesive compositions of claims 6 and 11.**

Should the rejection of Kinzer be reversed this rejection would also be reversed. However, further arguments against the combination of Kinzer in view of Wiest are made below in the event that the rejection based on Kinzer is affirmed.

Wiest describes a copolymer which has ranges for the amount of ethylene, vinyl acetate, acrylic acid and methacrylamide which overlaps that of the appellants' claims (presuming that there is equivalence for methacrylamide (Wiest) and acrylamide (appellants)). However, what is lacking is any motivation or suggestion to combine the teachings which come from the references themselves or from the known state of the art. The examiner's explanation appears to be based on hindsight reconstruction (i.e. presumes that the skilled artisan would have had a copy of the appellants' claims before him when considering the scope of the inventions represented by Kinzer and Wiest). This is not permissible according to MPEP 2142.

Going back in time to the filing date of the applicants claimed invention without the benefit of the appellants claims, one of ordinary skill in the art would already have to have made the remarkable selection of an amine despite the infinite number of additional adjuvants which could be selected and lack of knowledge of the success of using an amine and would then proceed to again pick among the infinite number of copolymers available to select the one described by Wiest. Such a presumption strains credulity and therefore, such a combination would not render the appellants' claimed invention to be obvious.

**(9) CONCLUSION**

For any of the foregoing reasons, Appellants respectfully request that the Honorable Board reverse the final rejection of claims 1 and 4-11.

<b>CONDITIONAL PETITION FOR EXTENSION OF TIME</b>
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If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

<b>ADDITIONAL FEE</b>
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Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,  
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NORRIS, McLAUGHLIN & MARCUS, P.A.

By Agata Gliniska

Agata Gliniska

Date 8 December, 2003

**(10) APPENDIX - CLAIMS ON APPEAL**

1. An adhesive tape provided on one side with a self-adhesive composition and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin, wherein

the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;

and wherein said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; araliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.

4. The adhesive tape according to Claim 1, wherein the crosslinked epoxy resin comprises fillers, plasticizers and, optionally, auxiliaries and additives as further formulating constituents.
5. The adhesive tape according to Claim 1, wherein on the reverse of the crosslinked epoxy resin there is a release coating.
6. The adhesive tape according to Claim 1, wherein the self-adhesive composition has the following makeup:

ethylene	from 10 to 30% by weight
vinyl acetate	from 20 to 55% by weight
acrylic ester	from 30 to 69% by weight
acrylamide	from 0 to 8% by weight.

7. The adhesive tape according to Claim 1, wherein the self-adhesive composition has a thickness of from 15 to 40  $\mu\text{m}$ .
8. A method for masking window flanges which comprises applying the tape of Claim 1 to said flanges.

9. A process for producing the adhesive tape of claim 1, which comprises applying a mixture of starting components of the epoxy resin during their chemical reaction phase directly on the polyester film.
10. The process of claim 9, wherein the polyester film is provided with the self-adhesive composition prior to coating with the crosslinked epoxy resin opposite the side to be coated with epoxy resin.
11. The adhesive tape of Claim 6, wherein
  - the amount of ethylene is 10 to 15% by weight,
  - the amount of vinyl acetate is 30 to 35% by weight,
  - the amount of acrylic ester is 50 to 60% by weight,
  - the amount of acrylamide is 0.5% by weight.